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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/059,765	04/14/1998	SHINICHI HIRATA	SONY-P8407	8893

7590 04/23/2004
Oblon Spivak McClelland Maier & Neustadt
1755 Jefferson Davis Highway
4th floor
Arlington, VA 22202

EXAMINER

SEAL, JAMES

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 04/23/2004

40

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/059,765

Applicant(s)

HIRATA, SHINICHI

Examiner

James Seal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Action is in response to applicant's correspondence of 02 February 2004.
2. Amendments to claims 1, 5, 6, 7, 8, 9, 11, and 12 have been entered.
3. Claims 1, 3-9, and 11-12 are pending.

Specification

4. The new title has been entered and is acceptable. Objection to the title is withdrawn.

Drawings

5. The amendment to Figure 1 is acceptable and has been entered. Objection to Figure 1 is withdrawn.

Claim Rejections - 35 USC § 112

6. Claim 1 recites the limitation "whether a sender of said electronic mail is an authorized user" in line 15. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-9, 11-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Naughton (US6020881 A) and further in view of Venkatraman US 5956487, A Bob

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Brown and Wayne Eckerson Users Demanding Help in Managing Big E-mail Nets, Dave Brambert and Patricia Schnaidt Network World Boston (Upgrade was the Watchword at the Skit-studded Expo), Schneier E-mail Security How to Keep Your Electronic Messages Private), Rohatgi et. al. US 5625693 A, and Cahill US 5428784 A.

8. As per claim 1, the limitation of a reception device (apparatus) for controlling for controlling a video recording device is disclosed by Naughton Figure 1a element 39 is a VCR or video cassette recorder (Column 8, line 53). Naughton shows 39 being remotely controlled via the Internet (element 160 and Column 1, lines 11-14) by the user using a hand held device (element 170). Naughton is silent on what interface is used to port the Internet communication signal into the house and whether that is directly connected to the interface device or whether the remote controlled device is physical separate from the interface device.

9. Venkatraman teaches (see Figure 5), both cases, that is the case where the interface (element 102) is physical separated from the Internet (100) and the case where the remotely controlled device is directly interfaced with the Internet device 10 and 100. One of ordinary skill in the art at the time that the invention were made would have motivated to have separated the remotely controlled device from the Internet interface because a house with several members would be provided with more access for programming from a number of house members or it would enable communication among a set of devices (Column 5, lines 31-35; 43-44).

10. Naughton and Venkatraman are both silent on the limitation that the control code is sent by email. Naughton teaches sending control codes to operate remote control

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devices over the communication network (Figure 21c, element 160), but is silent on what means (that is the transport protocol) is to be employed to do this (see Figure 24 element 129). Brambert et. al. teach the use of sending control commands via e-mail to operate a Fast 5000 AutoLoader tape remotely jukebox style (page 2, next to last paragraph) "so user can send requests to the [remote] unit via e-mail". Brown et. al. teach that transport of commands between application over a network will become of "strategic importance" as mainframes are downsized. "E-mail is expected to be used increasingly to carry strategic business information and to transport commands between application" (page 1, 4th paragraph). Thus one of ordinary skill in the art at the time of the invention was made, to provide for "some" means to transport commands across a network as disclosed by Naughton, would have been motivated to implement Brambert use of e-mail to transport control commands to operate devices (a tape autoloader in jukebox style) remotely over a network because as Brown point out with the businesses downsizing of mainframes, email nets will become increasingly important means to transport commands and to operate over a distributed system.

11. The limitation that the control codes are extracted (that is unpacked) from the transport protocol once they arrive at the site of the remote device is taught by Naughton (Column 28, 45-49) from the message and are then used to control remotely appliances, such as, TV or VCR or microwave oven or stereo, or thermostat (Column 7, 16-20, Figure 1b) is disclosed by Naughton. Further, the limitation that the remote controller has the means to store control commands (Figure 1c is a block diagram of the remote control device with memory). That the user may schedule programs to be

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recorded is disclosed by Naughton (Column 13, 4-7) and that corresponding schedules and scheduling, as shown in Figure 2c, are stored in Figure 1c 303. The examiner takes official notice that home VCR's have timers. Thus it would have been obvious for one of ordinary skill of the art at the time of the invention to have designed into the user's unit a means of using the Program Listing (element 71 Figure 2c) and to set the timer on the VCR (element 75) to record a program which was aired on Television (element 73) because users would then be allowed to record special events programs remotely.

The combination of Naughton/Venkatraman/Bramber/Brown are silent with regards to the limitation of encrypted certificates as a means for validating the sender before the stored control code is execute. Schneier teaches (E-mail Security and How to Keep Your Electronic Message Private), need to validate the sender of the email (pages 3-5). Rohatgi teaches the security for executable application by decrypting of an encrypted certificate (Abstract, Column 9, line 20-25; Column 11, lines 6-7) and validating whether the executable code was indeed sent by an authorized user. Therefore one of ordinary skill in the art would have been motivated to add some type of verification to the combination of Naughton/Venkatraman/Bramber/Brown system validating the user before executing the control codes to prevent terrorist, hackers, pranksters, etc. from intentional or unintentional modification. It would be inherent that the control commands would stay in storage until the validation of the sender were completed and that control code is executable. The Naughton/Venkatraman/Bramber/Brown/Rohatgi combination is silent on the scheduling conflicts. Cahill discloses a system which

provides an email to the sender when a conflict occurs in scheduling (See Abstract and Column 4, lines 15-18). It would have been obvious to one of ordinary skill in the art at the time that the invention was made, to combine the feature of electronic feedback via email when schedule conflicts occur, because if several people are interacting with the same device, scheduling problems will occur and this provides a means for avoiding them. Claim 1 is rejected

12. Claim 2 canceled.

13. As per claim 3, the limitation that certification information is predetermined text information in an encrypted state is disclosed by Rohatgi (Column 9, lines 10-13).

Claim 3 is rejected.

14. As per claim 4, the further limitation of using a secret key for the encryption is disclosed by Rohatgi (Column 5, lines 33-35). Claim 4 is rejected.

15. Claim 5 is a methods claim for device claim 1 and is rejected in view of the same prior art of record.

16. Claim 6 applicant recites a transmitting device that is the complement of the receiving device of claim 1 and is rejected in view of the same prior art of record.

17. Claim 7 recites a method of transmitting that is disclosed in device claim 6 and is rejected in view of the same prior art of record.

18. Claim 8 is a transmission/reception system encompassing device claims 1 and 5 and is rejected in view of the same prior art of record.

19. Claim 9 is a method for carrying out the transmission/reception system of claim 8 and is rejected in view of the same prior art of record.

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20. Claim 10 is canceled.

21. As per claim 11, the limitations of a terminal consisting of a modem for receiving electronic mail through a network, a memory, a CPU decrypting, extracting executing control commands and authentication is disclosed by Naughton (see Figure 1c, elements 401, 403, 404 and 405). Claim 11 is rejected.

22. As per claim 12, the limitation of a terminal with a display device using a GUI (graphical user interface) display is disclosed in Naughton (Figure 1b). Claim 12 is rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Response to Arguments

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23. With regards to the amended claims, Cahill meets the limitation of responding to the sender when a conflict occurs.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Seal whose telephone number is 703 308 4562.

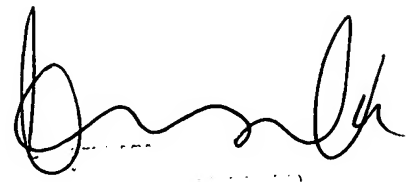
The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703 305 4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWS

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18 April 2004


James Seal
Examiner
Art Unit 2135